

### **REMARKS**

The issues outstanding in the FINAL Rejection mailed May 2, 2006, are the requirement for election and the rejections under 35 U.S.C. 102 and 103. Although not specifically indicated in the Office Action, it is clear that the failure to repeat the prior rejections under 35 U.S.C. 112 evidences the PTO's withdrawal of these rejections.

#### ***Requirement for Restriction***

Applicant's traversal of the requirement for restriction is maintained. It is argued, at page 2 of the Office Action that a sub-combination/combination relationship can only exist between two products, not between a product and a process. It is submitted that there is no such rule set forth in the code of federal regulations, or in the MPEP. The Examiner is invited to provide support for this argument. It is moreover submitted that, to the extent that the claims could *also* be classified as product and process, such potential dual classification of the claims means that all of the requirements for *each* classification *must* be satisfied for a restriction to lie. See MPEP § 803.01.

In any event, it is again submitted that rejoinder of the process claims under MPEP § 821.04 is appropriate, at such time as the product claims are allowed.

#### ***Rejections Under 35 U.S.C. 102***

At the outset, it is noted that the FINAL Rejection fails to repeat the prior rejections over Schmidt '070, over *Cloisonne Regal Gold* and *Flamingo Twilight Gold*. This failure to maintain the rejections is being taken as evidence that these rejections have been withdrawn.

Thus, the two rejections under section 102 remaining are as follows:

Claims 1-3, 6-9, 14-18, 21 and 22 are to be rejected under 35 U.S.C. 102(e) over Bauer '018. Bauer '018 discloses pigments comprising a substrate, a layer of titanium, zirconium, zinc, or iron oxides and, optionally, an additional tin or cerium oxide layer as a top layer. See, column 6, lines 10-17 and 63-67. The Patentees moreover indicate that, according to the invention, pigments containing "no more than 2 metal oxide layers are preferred." See column 7, lines 9 and 10. Accordingly, the patent fails to suggest a pigment comprising a platelet shaped substrate,

and coated thereon either (a) a layer comprising one or more of cerium, tin or iron oxides, and at least one set of metal oxide layers of tin followed by titanium, or (b) a layer unit of tin oxide and thereon titanium oxide, said unit *repeated* one or more times. Bauer not only suggests to one of ordinary skill in the art the use of two or less layers, but does not disclose a layer of cerium, tin or iron, and thereon a tin layer followed by titanium, i.e., three layer construction. Moreover, Bauer fails to disclose even a cerium layer adjacent to the substrate, instead disclosing only cerium or tin as a top layer. This is relevant to new, independent claim 28.

There is no guidance to one of ordinary skill in the art, in the specification or examples, which would lead to the above constructions. For example, all of the examples of Bauer which produce multilayer pigments produce, at most, pigments having two oxide layers thereon. Even those examples which contain tin as a first layer with titanium coated thereon (for example, example 6 and 7) do not produce constructions in which such a layer structure is repeated.

Accordingly, it is submitted that Bauer fails to anticipate, much less suggest, the presently claimed materials, withdrawal of the rejection is respectfully requested.

Claims 1, 6-9 and 14-18 have been rejected under 35 U.S.C. 102(b) over either Linton '828 or Nitta '034. Reconsideration of each of these rejections is also respectfully requested.

Linton discloses pigments comprising a platelet, titanium or zirconium oxide thereon, and, optionally, a second oxide layer which may be aluminum, zirconium, zinc, tin, antimony, titanium, iron, nickel, copper, cobalt, or chromium oxides. Patentees indicate, at column 10, lines 73-75, that deposition of successive layers of metal oxides can be extended beyond two successive layers. However, Patentees give no guidance as to what should be used for such additional layers, and, moreover, all examples in the patent have no more than two oxide layers on the substrate. Moreover, Patentees disclose only titanium or zirconium as the first oxide layer, adjacent to the substrate. Thus, the patent fails to suggest the presently claimed materials, in that it fails to suggest a first layer which is cerium, tin or iron, fails to suggest repeating units of tin followed by iron, etc. See independent claims 1, 27 and 28, for example. Thus, it is submitted that this patent also fails to anticipate or suggest the present claims, and withdrawal of this portion of the rejection is respectfully requested.

Nitta is directed to pigments comprising a substrate, thereon an oxide which can be titanium, iron, tin, chromium or zirconium, and thereon a layer of zirconium oxide, and a top layer of cobalt, manganese or cerium oxide. Patentees do not teach, even where a first layer of tin or iron is used, subsequent repeating layers of tin and titanium. Moreover, the Patentees do not teach layers of tin followed by titanium per se, much less a first layer of cerium. All examples of the patent produce three layer constructions, all having a first layer of titanium. Thus, the patent fails to teach the presently claimed materials, much less to suggest same. Accordingly, withdrawal of this portion of the rejection is also respectfully requested.

***Rejection Under 35 U.S.C. 103***

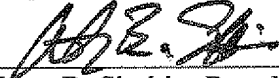
Claims 4, 5 and 26 have been rejected under 35 U.S.C. 103 over Bauer, Linton or Nitta taken with Franz '793. Reconsideration of this rejection is also respectfully requested.

Franz is cited principally for the disclosure of a magnesium oxide layer. See page 7 of the Office Action mailed June 14, 2005. In view of the above noted deficiencies of each of Bauer, Linton or Nitta, it is clear that Franz does not remedy the deficiencies. Franz fails to suggest a first layer of cerium, tin or iron, and subsequent repeating units of tin followed by titanium. Moreover, Franz fails to suggest the use of a first layer of cerium, relevant to independent claim 28. Accordingly, it is submitted that this rejection should also be withdrawn.

The claims of the application are submitted to be in condition for allowance. However, if the Examiner has any questions or comments, he or she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Attorney Docket No.: MERCK-2801

Date: November 6, 2006

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